

REMARKS

Claims 1 and 2 are pending in the instant application. Claim 3 is cancelled without prejudice to the prosecution of its subject matter in other applications.

The amendment to the specification filed on April 5, 2004, reciting the priority claim to International Patent Application No. PCT/US97/21687, filed November 27, 1997 and to United States Patent Application No. 08/755,034, filed November 22, 1996, now United States Patent No. 6,204,250, was not entered because the priority claim was not properly made during the time period required. Applicants submit herewith a Petition to request that priority be accorded, and repeat their request that the specification be amended.

Claim 3 is rejected as indefinite and anticipated. Claims 1 and 2 are rejected as anticipated. For reasons set forth below, all rejections should be removed and claims should be allowed to issue.

1. The Indefiniteness Rejections of Claim 3 is Obviated

Claim 3 is rejected under 35 U.S.C. § 112, second paragraph as being indefinite.

To advance prosecution of this application, claim 3 is cancelled without prejudice, thereby obviating the basis of this rejection, which should be removed.

2. The Claims are Not Anticipated by Bot

Claims 1-3 are rejected under U.S.C. § 102(b) as being anticipated by Bot *et al.* *Viral Immunology* 9(4):207-210 (1996) (“Bot”), because, according to the Examiner, (i) “Bot” teaches immunization of infant mice in addition to both the nucleic acid product and the method of use, and (ii) because Applicants’ priority claim is defective, “Bot” constitutes prior art. The Examiner notes that DNA vaccines were known at the time of filing, but while this technique was demonstrated to be effective in adults, it was not demonstrated that the technique could be extended to infants.

Pursuant to 35 U.S.C. § 120 and 37 C.F.R. § 1.78(a)(2), Applicants herewith submit a “Petition to Correct Priority Date Pursuant to C.F.R. §1.78(a)(2)” (the “Petition”), requesting that priority be accorded to International Patent Application PCT/US97/21687, filed November 27, 1997, and U.S. Patent Application Serial No. 08/755,034, filed on November 22, 1996 (“the ‘034 application”).

Applicants submit that claims 1 and 2 are fully supported by the disclosure of U.S. Application Ser. No. 08/755,034 as filed on November 22, 1996, so that if the accompanying Petition is granted, they would be entitled to this effective filing date. The cited reference of Bot *et al.* was published in *Viral Immunology* in December of 1996, and therefore would not constitute prior art against claims 1 and 2. Applicants respectfully request that, should the Petition be granted, the Examiner withdraw the rejection of claims 1 and 2.

3. **The Rejection of Claim 3 as Anticipated is Obviated**

Claim 3 is rejected under 35 U.S.C. § 102(b) as being anticipated by Lai *et al.* Hepatology 763-767 (1993), Assateerawatt *et al.* Asia Pacific Journal of Allergy and Immunology 11:83-91 (1993), and del Canho *et al.* Journal of Medical Virology 41:30-34 (1993).

To advance prosecution of this application, claim 3 is cancelled without prejudice, thereby obviating the basis of this rejection, which should be removed.

CONCLUSION

In view of the foregoing amendments and remarks and the accompanying
Petition, Applicants request that the rejections be removed

Applicants herein enclose a check for \$1,370.00, which represents the
required petition fees set forth under 37 C.F.R. § 1.17(t). Applicants believe that no
additional fees are due. If however additional fees are due, the Commissioner is hereby
authorized to charge payment of fees or to credit any overpayment associated with this
communication to Deposit Account No. 02-4377. Two copies of this paper are enclosed.

Respectfully submitted,

BAKER BOTTS, L.L.P.

A handwritten signature in black ink, appearing to read 'Lisa B. Kole', written over a horizontal line.

Lisa B. Kole,
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